

Remarks

Claims 1, 3, 4, and 6-27 are pending in the present application. Claims 6-22 have been withdrawn from consideration. New claims 26-27 have been added. Reconsideration of the instant application in view of the following remarks is respectfully requested. No new matter has been added via this Response.

Claim Rejections Under 35 U.S.C. § 103:

Claims 1, 3-4, and 23 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent No. 3,213,062 ("the '062 patent"). The '062 patent discloses the compound dimethyldifluoromethanamine which is not claimed in instant claim 1. The Office Action contends that in view of the '062 patent, the instantly claimed compounds are obvious. Applicants respectfully disagree.

First, the compound of the '062 reference is not featured within the scope of the pending claims as amended. As discussed in previously submitted argument, which is hereby incorporated by reference, the Applicants have argued that the compound of the '062 patent does not disclose the compounds recited in claim 1. The Office contends that the instantly claimed compounds are mere homologues of the compound recited in the '062 patent. The Applicants respectfully submit that the '062 patent does not disclose any of the instantly claimed compounds and, further, does not provide any motivation to modify the disclosed compounds to obtain those of instant claim 1. The '062 patent deals specifically with dimethyldifluoromethylamine and does not infer that other "similar" compounds would be useful in the treatment of cellulose filter paper. Therefore, one of skill in the art would not be motivated to use other similar compounds to treat cellulose filter paper to render instant claim 1 obvious. Withdrawal of the rejection is respectfully requested.

Further, claims 3 and 4 each directed or indirectly depend from claim 1 and are patentable over the cited reference for at least the same reasons as set forth with regard to claim 1. Withdrawal of the rejection of these claims is respectfully requested.

Claim 23 is directed to fluorinating agents comprising the compounds of formula (I). The '062 patent does not teach or suggest fluorinating agents comprising the compounds of formula (I) as recited in claim 23. There is no indication in the '062 patent that the compounds of instant claim 23 could be useful as fluorinating agents. The '062 reference discloses that dimethyldifluoromethylamine, which is specifically excluded in claim 23, may be used as a treating agent for cellulosic products but shows no enabled process for using the compound as a fluorinating agent. In fact, the '062 reference states that the fluorinated compounds obtained in the process of the '062 reference may serve as intermediates in the preparation of fluorine-containing compounds which are "difficult to obtain." *See the '062 patent, column 13, lines 53-63.* Since the '062 patent clearly states that fluorine-containing compounds are "difficult to obtain," there is nothing to motivate one of skill in the art to modify the disclosed compounds to arrive at suitable fluorinating agents. Further, even if one of skill in the art were to attempt such, it would require undue experimentation to arrive at suitable fluorinating agents, as claimed in instant claim 23. Moreover, there is no disclosure of any processes in the '062 patent showing how to fluorinate compounds. As such, one of skill in the art would not find the fluorinating agents of claim 23 obvious in view of the '062 patent. Withdrawal of the rejection is respectfully requested.

Claim 24 and recites compounds according to formula (I) wherein R¹ is hydrogen, C₄-C₁₂-alkyl and claim 25 recites use of the compounds of formula (I) wherein R¹ is hydrogen, C₄-C₁₂-alkyl as fluorinating agents. The '062 patent does not recite compounds of formula (I) wherein R¹ is hydrogen, C₄-C₁₂-alkyl. The '062 patent deals specifically with dimethyldifluoromethylamine and does not infer that other "similar" compounds would be useful in the treatment of cellulose filter paper. Therefore, one of skill in the art would not be motivated to use other similar compounds to treat cellulose filter paper to render instant claim 24 obvious. Withdrawal of the rejection is respectfully requested.

New claim 26 is directed to 1,1-difluoro-N,N-2,2-tetramethyl-1-propanamine which is not disclosed in the '062 reference. Furthermore, previously submitted was a Declaration showing unexpected results of 1,1-difluoro-N,N-2,2-tetramethyl-1-propanamine over 1,1-difluoromethyl-N,N-dimethylamine. Specifically, 1,1-difluoro-N,N-

2,2-tetramethyl-1-propanamine showed much higher diastereomeric excess when used as a fluorination reagent over 1,1-difluoromethyl-N,N-dimethylamine. Even though such unexpected results may not be disclosed in the instant Specification, evidence and arguments directed to advantages not disclosed in the specification cannot be disregarded. See MPEP 716.02(f). As such, the compound of instant claim 26 is not obvious and allowance of claim 26 is respectfully requested.

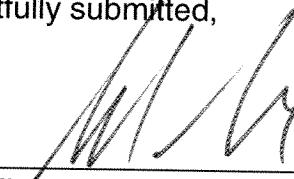
New claim 27 is directed to fluorinating agents comprising the compound of claim 26. The '062 patent does not disclose fluorinating agents comprising 1,1-difluoro-N,N-2,2-tetramethyl-1-propanamine. Furthermore, at best, the '062 patent discloses fluorinating intermediates of 1,1-difluoromethyl-N,N-dimethylamine but the '062 patent adds that fluorine-containing compounds are "difficult to obtain." As such, one skilled in the art would not find any motivation to modify the compounds of the '062 reference to use as fluorinating agents. Further, because the '062 patent specifically states that such compounds are difficult to obtain, even if one skilled in the art were to modify the compounds of the '062 patent, there is no likelihood that the compounds would be successful in the preparation of fluorine-containing compounds. Based on the teachings in the '062 patent, only 1,1-difluoromethyl-N,N-dimethylamine can be the only basis for a rejection under 103(a). Allowance of claim 27 is respectfully requested

In view of the foregoing, claims 1, 3-4 and 23-27 are now in condition for allowance. A response to the Amendment in the form of a Notice of Allowability is hereby solicited.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 C.F.R. 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully submitted,

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